



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

MAY 17 2006

TECHNOLOGY CENTER 2100

Robert C. Kowart
P.O. Box 398
Austin, TX 78767-0398

In re Application of: Byrne, et al.
Application No. 10/045,682
Attorney Docket No. 5681-06200
Filed: 10/29/2001
For: MACRO-BASED ACCESS
CONTROL

)
) DECISION ON PETITION FOR
) SUPERVISORY REVIEW REGARDING
) FINALITY OF RESTRICTION
) REQUIREMENT UNDER 37 CFR
) §1.144

This is in response to the petition filed on April 27, 2006, under 37 CFR 1.144 requesting supervisory review of the finality of a restriction requirement made in the Final Office action mailed on January 17, 2006. Note, A petition under 37 CFR §1.144 will not be considered if reconsideration of the requirement was not requested (see §1.181).

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

- (1) An election by original presentation restriction requirement was mailed in the final Office action on January 17, 2006, in which original claims 1-44 were acknowledged as having been canceled and newly added claims 45-88 were subject to an election by original presentation restriction requirement.
- (2) On February 20, 2006, an after final response was filed, traversing the restriction requirement set forth in the final Office action and requested reconsideration of same.
- (3) On March 23, 2006, the Examiner issued an advisory action setting forth additional details of the restriction requirement made in the final Office action and thus made such requirement final.
- (4) On April 27, 2006, the instant petition was filed by Petitioner, under 37 CFR §1.144.

RELIEF REQUESTED

The instant petition under 37 CFR 1.144 requests the following relief: withdrawal of the restriction requirement of January 17, 2006 (made final in the advisory action of March 23, 2006)

ANALYSIS

Petitioner provides arguments in support of the withdrawal of the election requirement including reference to M.P.E.P. § 808, which states:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why ****>each invention< as claimed *>is<** either independent or distinct **>from the other(s)<**; and (B) the reasons **>why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons<** for insisting upon restriction therebetween as set forth in the following sections.

In addition, as set forth in M.P.E.P. § 808.01:

****>**The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed. Each relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth. Form paragraphs 8.01, 8.02, and 8.14 - 8.20.02 may be used as appropriate to explain why the inventions as claimed are independent or distinct. See MPEP § 806.05 - § 806.06.**<**

The final Office action of January 17, 2006 merely identifies the two groups or sets of claims and their indicated classification i.e. Group I, claims 1-44, class 707 subclass 10 and Group II, Claims 45-88, class 709 subclass 229. Thus the Office action fails to provide the reasons why each invention as claimed is deemed to be independent and distinct from the other and the reasons why there would be a serious burden on the examiner if the restriction is not required.

Thus, and in accordance with M.P.E.P. § 808 and § 808.01, the election by original presentation restriction requirement of January 17, 2006, as set forth in the final Office action, is incomplete and therefore deemed to be improper.


The petition is **GRANTED**. The final Office action and restriction requirement is hereby **VACATED**.

The application is being forwarded to the Technology Support Staff to **WITHDRAW** the final Office action, to **ENTER** the after final response filed February 20, 2006 in accordance with M.P.E.P. § 706.07(e) and then **FORWARD** to the Examiner for appropriate action i.e. consideration of the amendment filed November 2, 2005, consistent with this decision.

Should the Examiner maintain the position with respect to the newly presented claims being drawn to an invention that is independent and distinct from the originally claimed invention, attention is directed to M.P.E.P. 714.19(N) which states:

(N) An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention ***should not be entered. Such an amendment is nonresponsive.*** Applicant should be notified as directed in MPEP § 714.03 and § 714.05. See MPEP § 821.03.

Any inquiries related to this decision may be directed to the undersigned at (571) 272-3595.



Brian L. Johnson, SPRE
Technology Center 2100
Computer Architecture, Software, and Information Security